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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,076	07/27/2005	Heinz Hornung	2732-157	2799
6449 7590 07/29/2008 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER				
HAGEMAN, MARK				
ART UNIT		PAPER NUMBER		
3653				
NOTIFICATION DATE		DELIVERY MODE		
07/29/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary

Application No.

10/520,076

Applicant(s)

HORNUNG ET AL.

Examiner

Mark Hageman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazur in view of Conant (US 5,680,472), Waine et al. ("Waine") (5,462,149) and Brotherston (US 7,044,463)... Mazur (Fig. 1-8) teaches a machine and method for adjusting a bank note processing machine wherein threshold values of sensors are defined for recognizing bank notes unfit for circulation, comprising selecting at least one bank note fit for circulation (col. 2, ln. 59-68 teaching use of master currency bills), processing the selected bank notes by means of the bank note processing machine, whereby data of at least one sensor are stored and defining at least one threshold value for the at least one sensor by evaluating the stored data of the at least one sensor (col. 4 et seq. teaching use of multiple sensors, such as optical, size, UV reflectance and/or magnetic content, and "learn" mode to capture/define parameters or ranges of values of "genuine" banknote from range of previously known values for different kinds-e.g., denominations-of banknotes). Mazur does not explicitly disclose selecting at least one bank note unfit for circulation. Mazur as set forth above teaches or renders obvious all that is claimed except for expressly teaching that the bank notes fit for circulation and those unfit for circulation are separated from each other by means of a separation card,

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the separation card being recognized during processing; that at least one of the rate of the bank notes fit for circulation or the rate of those unfit for circulation is specified and that the at least one threshold value is formed by a discriminant function. These features, however, are well-known in the banknote validating arts. Brotherston teaches the use of separator cards as "usual" in processing bank notes, for the purpose of separating one batch from another (c1 lines 10+). Further, Conant expressly teaches the use of a discriminant function in establishing proper authenticity thresholds and also teaches that the use of said function offers better and more efficient processing (col. 10). Waine expressly teaches money validators that use "unfit" units to assist with the fine tuning of threshold values/ranges (col. 7-8). It would thus be obvious to one with ordinary skill in the art to modify the base reference with these prior art teachings to arrive at the claimed invention. The rationale for this obviousness determination can be found in the prior art itself as cited above. Further, the rate of processing can be regarded a mere design choice that is determined by design incentives and/or economic considerations involved in this type of subject matter. Further, the prior art discussed and cited demonstrates the level of sophistication of one with ordinary skill in the art and that these modifications would be well within this skill level. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Mazur for the reasons set forth above.

Response to Arguments

2. Applicant's arguments filed 4-25-2008 have been fully considered but they are not persuasive. Regarding the anticipation rejection relying solely on Mazur the applicant's remarks are persuasive and this rejection has been withdrawn. Regarding the rejection under 103 of claims 1-12 applicant's remarks are not persuasive. Brotherston has been cited to show specific evidence of the use of separator cards in bank note processing. Applicant stated relative to Mazur, Conant, and Wayne that they, "have nothing to do whatsoever with determining whether a bill is fit or unfit for circulation." Examiner disagrees and maintains that authenticity and even denomination can be considered characteristic of fitness. Examiner contends that a fraudulent bill (not authentic) is not fit for circulation. Applicant pointed to the specification regarding the meaning of fit and unfit. While examiner acknowledges the applicant's disclosure it is maintained that the statements made do not provide a specific definition of fitness but rather give a few examples of various characteristics. Therefore examiner contends that the applicant's disclosure, while providing a few examples, does not provide a definition for fitness that would preclude authenticity or denomination determination.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Hageman whose telephone number is (571) 272-3027. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/

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Supervisory Patent Examiner, Art
Unit 3653

MCH